

[applying] providing a non-steroidal nasal cleaning composition consisting of a salt and water base and containing a mucolytic agent [(L-n-acetyl L-cysteine)] and methyl salicylate, an antiseptic, an analgesic, a decongestant, a moisturizer and a non-steroidal anti-inflammatory the composition being a liquid and having a comfortable pH for introduction into the nasal passages; and,

applying the liquid composition to the nasal passages.

REMARKS:

Reconsideration and removal of the grounds for rejection are respectfully requested.

Claims 1 through 9 were in this application, claims 1, 3 and 8 have been amended.

Claim 1 has been amended to clarify the invention, as consisting essentially of a non-steroidal liquid composition, having a comfortable pH for introduction into the nasal passages. The term "decongestant" has been changed in claims 1 and 3, to conform to the specification, p. 2, l. 4-6, l. 22-28, and p. 3, l. 6-8.

The examiner rejected claims 1, 2 and 4-6 as being anticipated by Hughes, et al. To find anticipation, each and every element of the claim must be found in a single prior art reference. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220, U.S.P.Q. 303 (Fed. Cir. 1983). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the art in possession of the invention. In re Spada, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990). An anticipatory reference must be enabling, containing adequate descriptions for practicing the applicant's invention. Akzo N.V. v. Intn'l Trade Comm., 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Hughes et al does not disclose any liquid nasal passage cleaning composition as required by applicant's claim 1. Hughes discloses a topical aromatic releasing composition formulated for external use. It is the release of the aromatic composition which is likely inhaled by the user that is alleged to be therapeutic, and no example of any formulation designed for internal use within the nasal passages is found. The examples list many ingredients which may be suitable for topical applications which certainly would not be compatible for utilization in a nasal passage cleaning composition. For example, the first example contains 2% turpentine.

The applicant is not claiming to have invented individual components that are admittedly in the prior art. Rather the applicant has invented a unique combination of ingredients, for a novel use, as a non-steroidal nasal passage cleaning composition. Hughes et al discloses a general laundry list of potential ingredients that could be used in topical applications, but lacks an enabling disclosure of the inventive composition. As the Federal Circuit has stated, "even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling". In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985).

Certainly, the method of claim 8 is nowhere anticipated by Hughes as there is nothing in Hughes to enable one to formulate any composition for introduction into the nasal passages, an internal, not external (topical) application. Therefore, claims 1-2 and 4-6 are not anticipated by Hughes.

Claims 3, 8 and 9 were rejected under 35 USC 103(a) as being unpatentable over Hughes in view of Bryce-Smith and further in view Pan et al.

It has clearly been established that obviousness cannot be found by combining the teachings of prior art references to produce the claimed invention absent a teaching, suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiori Hospital, 221 U.S.P.Q. 929(Fed.

Cir. 1984). "Citing references that merely indicate that isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious." Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, (POBA 1988). Also, to establish obviousness, "both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

The applicants' invention is a non-steroidal nasal passage cleaning composition, and method of use. There is nothing in Bryce-Smith, cited as disclosing the use of zinc sulfate nasal spray for treating the common cold, which even suggests any composition for cleaning the nasal passages, let alone the particular combination of components of claim 3, nor any method for cleaning the nasal passages.

Certainly, a composition allegedly useful for treating the common cold, will not necessarily be used for cleaning the nasal passages, and there is nothing which teaches or suggests the particular combination as described in the applicant's invention. Further, Hughes discloses topical compositions, and there is no teaching or suggestion which would support picking and choosing from Hughes various components to combine with the zinc spray described in Bryce-Smith, and absent a teaching, suggestion or incentive for doing as the applicant has done, such a proposed combination is improper.

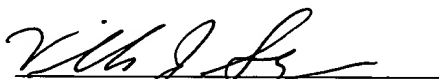
The examiner's reliance on Pan et al is also misplaced. Pan discloses a oral delivery system, utilizing a candy base to produce lozenges, which bears no reasonable relationship with a liquid non-steroidal nasal cleaning composition for cleaning the nasal passages. Looking objectively at each reference as a whole, it would be virtually impossible for one of skill in the art to pick and choose among the various disclosures to arrive at the applicants' invention. The

piecemeal construction proposed by the examiner can only be a hindsight reconstruction, using the applicants' disclosure as a guide through the maze of prior art, and this is an improper basis for rejecting these claims.

None of the cited references teach or suggest the particular combination of components as described in the applicant's intention, nor even the application of such a composition for cleaning the nasal passages, and so the rejection should be withdrawn.

Based on the above amendments and remarks reconsideration and removal of the grounds for rejection are respectfully request. However should the examiner believe that direct contact with the applicants' attorney would advance the prosecution of this application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,


William J. Sapone
Registration No. 32,518
Attorney for Applicant(s)

Coleman Sudol Sapone P.C.
714 Colorado Avenue
Bridgeport, CT 06605
Telephone No. (203) 366-3560
Facsimile No. (203) 335-6779